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IN THE

Supreme Court of the United States

October Term, 1963

No. 507

HAHN & CLAY, *Petitioner*,

v.

A. O. SMITH CORPORATION, *Respondent*

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

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STATEMENT

This is an ordinary patent case. There is but one patent in suit (Jasper 2,480,369 R# 1082-1084) and this patent will expire on August 30, 1966. This patent does not purport to establish a monopoly on multi-layer pressure vessels or on all methods of manufacturing multi-layer pressure

vessels. All of its claims are limited to one particular method of manufacturing multi-layer pressure vessels.

The U. S. Government's missile program is not affected by this action because the U. S. Government did not specify the use of this particular method of the Jasper patent. Had the Government done so, Respondent could not have maintained this action in view of 28 U.S.C. §1498.

There are no conflicting decisions of different circuits on this Jasper patent. This is the first and only suit that has been filed for infringement of this patent.

Petitioner's professed inability to ascertain the force to be used in practicing the Jasper method finds no support in the record. The specification of the Jasper patent (R 1082-1084) states (col. 3, line 28) that a force of as high as 35 tons had been used by him on each band. And the record establishes that Petitioner used a force as high as 32 tons on each band (R 148, 156, 163 Gage Reading 1600 lbs.)

As to the Alleged Questions Presented

By its alleged *Question #1*, Petitioner implies that there is a question of law as to the 1952 amendment to Title 35 U.S.C. §112. There is no such question, and Petitioner has not cited any part of the record to support this implication.

As the Court of Appeals stated (p. 14 Exhibit B of Petition):

> "The applicable *legal principles are clear* enough. Jasper 369 is invalid * * if its claims are not sufficiently specific to apprise the public of the limits of the monopoly. 35 U.S.C. §112 * * "

> "The issues involved here are, as the trial judge observed, close ones, and the difficulty lies in applying the established principles to *the facts* of this particular case." (Emphasis added);

and (p. 16 Exhibit B of Petition):

> "We are further in accord with the finding that the claims of the Jasper patent sufficiently define the monopoly for its method."

and (footnote 22, p. 16 Exhibit B of Petition):

> "The defects in the patents involved in General Electric Co. v. Wabash Appliance Corp. 1938, 304 U.S. 364, relied upon by Hahn & Clay, are not present here."

With respect to Petitioner's alleged *Question #2*, it was not "difficult or impossible" for Jasper to distinguish the earlier patent (Stresau). The Jasper patent itself refers to the earlier Stresau patent, and the Patent Office found that the allowed Jasper claims distinguish it. So did the District Court. So did the Court of Appeals. The Jasper patent claims define the monopoly (p. 14, 16, Exhibit B of Petition above quoted).

As to the Statute Involved

There is no reason for the Supreme Court to consider in this case the third paragraph of §112 added in 1952 because the courts below have not decided any question with respect thereto.

As to the Alleged Reasons for Granting the Writ

As to alleged *Reason No. 1*, no novel question is here presented with respect to Sec. 112 of the Patent Codifica-

tion Act of 1952 (Title 35 U.S. Code). This will be apparent from the fact that *all* of the Supreme Court cases cited by Petitioner as "the controlling Supreme Court law" (p. 5 of Petition) were decided prior to 1952; that is, between 1938 and 1949.

The courts below have not decided any question which has not been settled by the Supreme Court, nor any question in conflict with the applicable decisions of the Supreme Court.

As the Court of Appeals pointed out in its footnote 22 (p. 16 Exhibite B of Petition) the defects in the patents involved in *General Electric Co. v. Wabash* relied upon by Petitioner (Hahn & Clay) are not present here.

As to alleged *Reason No. 2*, in the *Siegel* case, cited by Petitioner (p. 7 of Petition), the court based its decision on the third paragraph of §112, whereas in the present case the court did not. Therefore, there is no conflict between the *Siegel* case and the present case, and no reason in the present case for the Supreme Court to interpret the said third paragraph.

Also, *a different patent* was involved in the *Siegel* case; and as the Supreme Court stated in *Keller v. Adams-Campbell Co.*, 264 U.S. 314, 319 (1924):

> "Such an ordinary patent case with the usual issues of invention, breadth of claim and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

In *Layne & Bowler Corp. v. Western Well Works*, 261 U.S. 387 (1923), the Supreme Court held that the writ of

certiorari should not be granted (page 319): "except in cases involving principles, the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeals."

As to alleged *Reason No. 3*, as Respondent has explained above, this case presents no question of importance with respect to the missile program of the U. S. Government.

In *Mackay v. Radio Corp. of America*, cited by Petitioner, the Supreme Court said (page 89):

> "We granted certiorari, 305 U.S. 582, *because of the nature and importance of the case*, on a petition which urged as grounds for its allowance that validity and infringement of the Carter patent were in doubt and that, as petitioner is the only competitor of respondent in the business of *world wide public radio communication*, further litigation, resulting in conflict of decision among circuits, was impossible." (Emphasis ours.)

Obviously, the present case involving only one patent limited to a particular method of manufacturing multilayer pressure vessels and which will expire on August 30, 1966, is clearly distinguishable from the *Mackay* case.

As to alleged *Reason No. 4*, an injunction is not an extraordinary remedy in a patent case. Where the courts find a patent valid and infringed, injunctions are usually and normally granted, under the authority given by the statute 35 U.S.C. §283. Both the District Court and the Court of Appeals found the patent valid and infringed and granted the injunction accordingly.

Conclusion

It is respectfully submitted that the Petition for a writ of certiorari shall be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Service of this Brief for Respondent has been made upon Hahn & Clay, Petitioner, by mailing a copy thereof to Mr. B. R. Pravel, its attorney, 500 Jefferson Bldg, Houston 2, Texas, this _____ day of October, 1963.

_____
Attorney for Respondent